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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.
08/860,844	09/29/97	WEININGER	S GP-100C1

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HM12/0224

EXAMINER

MARSCHER, A

ART UNIT	PAPER NUMBER
1634	11

DATE MAILED: 02/24/99

Please find below and/or attached an Office communication concerning this application or proceeding.

Commissioner of Patents and Trademarks

Office Action Summary

Application No.
08/860,844

Applicant(s)
Weininger et al.

Examiner
Ardin Marschel

Group Art Unit
1634



☒ Responsive to communication(s) filed on Dec 1, 1998

☐ This action is **FINAL**.

☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11; 453 O.G. 213.

A shortened statutory period for response to this action is set to expire 3 month(s), or thirty days, whichever is longer, from the mailing date of this communication. Failure to respond within the period for response will cause the application to become abandoned. (35 U.S.C. § 133). Extensions of time may be obtained under the provisions of 37 CFR 1.136(a).

Disposition of Claims

☒ Claim(s) 1-51 is/are pending in the application.

Of the above, claim(s) 1-25, 31-41, 46-48, 50, and 51 is/are withdrawn from consideration.

☒ Claim(s) 44 is/are allowed.

☒ Claim(s) 26-30, 42, 43, 45, and 49 is/are rejected.

☐ Claim(s) _____ is/are objected to.

☒ Claims 1-51 are subject to restriction or election requirement.

Application Papers

☒ See the attached Notice of Draftsperson's Patent Drawing Review, PTO-948.

☐ The drawing(s) filed on _____ is/are objected to by the Examiner.

☐ The proposed drawing correction, filed on _____ is ☐ approved ☐ disapproved.

☐ The specification is objected to by the Examiner.

☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. § 119

☐ Acknowledgement is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d).

☐ All ☐ Some* ☐ None of the CERTIFIED copies of the priority documents have been
☐ received.

☐ received in Application No. (Series Code/Serial Number) _____.

☐ received in this national stage application from the International Bureau (PCT Rule 17.2(a)).

*Certified copies not received: _____

☐ Acknowledgement is made of a claim for domestic priority under 35 U.S.C. § 119(e).

Attachment(s)

☒ Notice of References Cited, PTO-892

☐ Information Disclosure Statement(s), PTO-1449, Paper No(s). _____

☐ Interview Summary, PTO-413

☒ Notice of Draftsperson's Patent Drawing Review, PTO-948

☐ Notice of Informal Patent Application, PTO-152

— SEE OFFICE ACTION ON THE FOLLOWING PAGES —

Applicants' election without traverse of Group II (claims 26-30, 37, 38, 42-45, and 49) in Paper No. 10, filed 12/1/98, is acknowledged.

This application contains sequence disclosures that are encompassed by the definitions for nucleotide and/or amino acid sequences set forth in 37 CFR § 1.821(a)(1) and (a)(2). However, this application fails to comply with the requirements of 37 CFR § 1.821 through 1.825 because no submission of computer readable form sequences etc. has been submitted and accompanying verifications regarding computer readable sequences and paper copies. Applicants are given the same response time regarding this failure to comply as that set forth to respond to this office action.

Claims 26-30, 42, and 49 are rejected, as discussed below, under 35 U.S.C. § 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Claims 26-30 are vague and indefinite due to depending from non-elected claim 12 either directly or indirectly. Further, it is noted that claim 12 contains the abbreviation "OSA" which is unclear as to what such an abbreviation indicates without its full name being also given. Claim 42 is also unclear due to depending from non-elected claim 1. Further, it is noted that claim 1 contains several abbreviations which are not given their

full names therein. Claim 49 also cites several abbreviations which are unclear without their full name definitions therein.

The following is a quotation of the appropriate paragraphs of 35 U.S.C. § 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless --

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

Claims 26, 27, 30, 37, 38, 43, and 45 are rejected under 35 U.S.C. § 102(b) as being clearly anticipated by Larson et al.

Larson et al. discloses the preparation of nicked double-stranded templates and oligonucleotide primed ss templates as given on page 2472 of Larson et al. The right column, last full paragraph, on page 2472 describes hybridization between denatured, restriction enzyme cleaved M13 molecules with viral-strand DNA. On page 2473, bridging paragraph between the left and right columns, either nicked double-stranded DNA or primed single-stranded DNA are recognized by E. coli polymerase. This recognition is specific for the 3'-termini at nicks or primers therein. The above described fragmentation of DNA followed by hybridization of oligonucleotides or primers and polymerase recognition reads on instant claim 26. The practice of recA or ss binding protein (ssB) binding to the above described nicked double-stranded DNA, formed by hybridization as given on page

2477, bridging paragraph between the left and right columns, also reads on instant claim 26. The multiple hybridizing fragments of the reference additionally provide multiple binding site for the above enzymes and therefore read on the limitation in instant claim 27. Instant claim 30 is anticipated by the reference in that gel electrophoretic analysis is performed to size the products of the reactions with the respective enzymes.

Pathogenic conditions are disclosed in Larson et al. in that UV induced lesions are analyzed with respect to RecA and/or ssB protein activity as also the limitations of instant claims 37 and 38. The components of the above described hybridized complexes also meet the limitations of instant claims 43 and 45.

Due to unavailability of the reference copies corresponding to the citations on the PTO Form 1449, filed 8/27/97, as of the mailing of this office action, the references cited thereon will be considered in connection with the next action.

Claim 44 is allowed.

Papers related to this application may be submitted to Group 1600 by facsimile transmission. Papers should be faxed to Group 1600 via the PTO Fax Center located in Crystal Mall 1. The faxing of such papers must conform with the notices published in the Official Gazette, 1096 OG 30 (November 15, 1988), 1156 OG 61 (November 16, 1993), and 1157 OG 94 (December 28, 1993) (See 37 CFR § 1.6(d)). The CM1 Fax Center number is either (703) 308-4242 or (703) 305-3014.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Ardin Marschel, Ph.D., whose telephone number is (703) 308-3894. The examiner can normally be reached on Monday-Friday from 8 A.M. to 4 P.M.

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If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, W. Gary Jones, can be reached on (703) 308-1152.

Any inquiry of a general nature or relating to the status of this application should be directed to the Chemical Matrix receptionist whose telephone number is (703) 308-0196.

February 16, 1999

Ardin H. Marschel
ARDIN H. MARSCHEL
PRIMARY EXAMINER